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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 10/777,019 | 02/11/2004 | Tushar Patel | 101896-234 (DEP5100CIP) | 2233 |
| 21125 7590 02/20/2009 NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604 | | | EXAMINER COMSTOCK, DAVID C | |
| | | | ART UNIT 3733 | PAPER NUMBER |
| | | | NOTIFICATION DATE 02/20/2009 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/777,019 | Applicant(s) PATEL ET AL. | |
| | Examiner DAVID COMSTOCK | Art Unit 3733 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10-18 and 27-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10-18 and 27-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The new drawings filed 12 November 2008 are accepted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

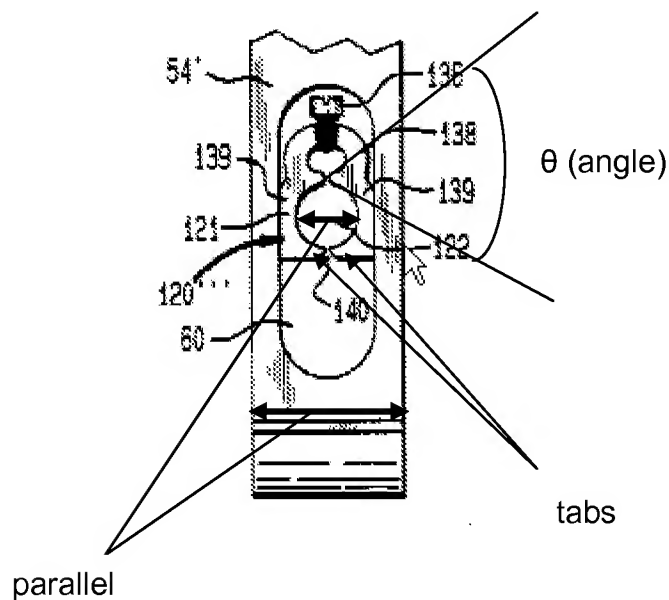
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 10-18, 27, 28, 31-36 and 40-55 rejected under 35 U.S.C. 102(b) as being anticipated by Greenberg (5,558,622; of record).

Greenberg discloses the claimed invention including elongate members, e.g. 54' and guides comprising first and second pathways (see openings in element 120"). See Fig. 27B and illustration below. A cut-out portion extends between the two openings or pathways (id.). The cutout is formed through the guide, which necessarily includes at least the sidewall between the pathways. The pathways extend parallel to a portion of a front surface of the distal portion of the elongate member (see illustration, below). The pathways are positioned at an angle with respect to one another. The guide comprises various sidewalls and the opposed lateral sidewalls comprise a C-shape. The guide includes extension portions comprising first and second tabs extending from opposed lateral sidewalls of the guide member. Each tab has a concave inner surface. The

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guide has a width that is less than a distal portion of the elongate member. A distal portion of the elongate member comprises a planar portion and is positioned at an angle with respect to a back sidewall of the guide member. The device can comprise a single retractor or be coupled with a second retractor by a handle, which can be considered a cross member since it connects the two (see, e.g., Fig. 20). It is noted that the elongate member comprises a proximal handle *portion* (i.e. a portion to which the handle is connected), as claimed, as well as a cross member (i.e. the handle itself). In addition, claim 55 does not recite any particulars regarding the handle being removably connected. The device is capable of being used in the claimed manner.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29, 30 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg (5,558,622; of record).

Greenberg discloses the claimed invention except for explicitly reciting the clamp and post. However, as already memorialized during prosecution, Applicant has admitted that clamp members and posts are well known in the art. In accordance with this, it would have been obvious to have provided the device of Greenberg with a clamp member(s) and a post(s), for example, to facilitate positioning of the device and/or retraction of the patient, since adding clamp members and posts to retraction devices is old and well-known in the art. It also would have been obvious to have made the cross member (handle) removable, for example to facilitate cleaning or storage, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Moreover, determining an appropriate configuration, e.g., rectangular, elongated rod, etc., would have merely amounted to an obvious design choice, as there is no apparent, particular benefit to such designs and it appears that a connector would perform equally well without such a design.

Response to Arguments

Applicant's arguments filed 12 November 2008 have been considered but are moot in view of the new rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/
Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733